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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/505,440

08/24/2004

Eberhard Ammermann

3165-107

2309

6449

7590

05/01/2008

ROTHWELL, FIGG, ERNST & MANBECK, P.C.

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SUITE 800

WASHINGTON, DC 20005

EXAMINER

PURDY, KYLE A

ART UNIT

PAPER NUMBER

1611

NOTIFICATION DATE

DELIVERY MODE

05/01/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

Office Action Summary	Application No. 10/505,440	Applicant(s) AMMERMANN ET AL.	
	Examiner Kyle Purdy	Art Unit 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2004 and 20 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) 3-9, 12 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2 pages (08/24/2004 and 09/12/2007)</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election Acknowledged

1. Applicant's election with traverse of the invention of Group I encompassing claims 1-6 and 11 in the reply filed on 03/20/2008 is acknowledged. The traversal is on the ground(s) that Groups I and II are linked by the compounds being present together in a synergistically effective amount wherein Group II defines what the synergistic amounts are. Traversal is also on the grounds that the applied reference to break unity US 6787567 does not teach using prothioconazole and trifloxystrobin together and is directed to always using methoximinoacetamide in combination with other fungicidal compounds such as trifloxystrobin and prothioconazole. These arguments are respectfully not found persuasive. Group I and Group II are distinct from one another because they require different functions in order to properly operate. Group I requires prothioconazole and at least one other fungicidal compound whereas Group II requires that prothioconazole be used in combination with all of the fungicidal compounds listed as 'at least one selected from' compounds of Group I. Therefore, Group II would require an entirely different search from Group I as there is no common inventive feature. With respect to Applicants traversal of the validity of the applied reference to break unity, Applicants argument is not found persuasive. The MPEP states that lack of unity can be applied using a document which shows the claimed invention as being obvious. US6787567 illustrates that trifloxystrobin and prothioconazole are common fungicides, obviating their combination, thereby breaking unity of invention in the instant application.

2. Therefore, the requirement is still deemed proper and is therefore made FINAL.

Status of Application

3. Claims 1-9 and 11-13 are pending, claims 2-9 and 12-13 are withdrawn from consideration as being drawn to non-elected invention and/or species and claims 1,2 and 11 are presented for examination on the merits. The following rejections are made.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wachendorff-Neumann et al. (US 6787567; of record).

6. The teaching of Wachendorff-Neuman et al. ('Wachendorff) is drawn to fungicidally active compound combinations. It is disclosed that prothioconazole (compound XXI, see column 6, lines 5-10; see instant claims 1 and 2) and trifloxystrobin (compound XII, see column 4, lines 20-25; see instant claims 1 and 2) are fungicides which can be used in the active combination. It is taught that the active fungicidal compound combinations are present in a solid or liquid carrier (see column 26, lines 62-68; see instant claim 11).

7. Thus, it would have been obvious to one ordinarily skilled in the art at the time the invention was made to use and modify the teaching of Wachendorff with a reasonable

Art Unit: 1615

expectation for success in arriving at a active fungicidal mixture wherein the mixture comprises prothioconazole and trifloxystrobin. Although the teaching of Wachendorff doesn't specifically teach using the compounds together, it would still have been obvious to combine them and arrive at a composition having the instant properties. According to the MPEP (2144.06), it is *prima facie* obvious to combine two compounds each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. So even though Wachendorff fails to use the two compounds together, the mere fact that both compounds are commonly used as fungicides, one of ordinary skill would have motivated to combine them with a reasonable expectation for success in arriving at a composition with the instantly claimed properties.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle A. Purdy whose telephone number is 571-270-3504. The examiner can normally be reached from 9AM to 5PM.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 1615

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Kyle Purdy/
Examiner, Art Unit 1611
April 15, 2008*

/MP WOODWARD/
Supervisory Patent Examiner, Art
Unit 1615